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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/333,534	06/14/1999	TIMOTHY W. CONNER	38-21(15404)	4215

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EXAMINER

MARSCHER, ARDIN H

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 12/03/2001

11

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/333,534

Applicant(s)
Conner et al.

Examiner
Ardin Marschel

Art Unit
1631



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on Sep 21, 2001

2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1035 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1 is/are pending in the applica

~~1-7 of the above~~ Claim(s) 2-7 have been canceled. ~~were withdrawn from consideration~~

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) ☒ Information Disclosure Statement(s) (PTO-1449) 3 sheets

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

19) ☐ Notice of Informal Patent Application (PTO-152)

20) ☐ Other:

Applicants' arguments, filed 9/21/01, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

UTILITY REJECTION:

35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

The following is a quotation of the first paragraph of 35

U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1 is rejected under 35 U.S.C. § 101 because the claimed invention lacks patentable utility due to its not being supported by either specific and/or substantial utility or a well established utility.

This rejection is reiterated and maintained from the previous office action, mailed 6/5/01. Applicants argue that the claimed nucleic acids do have several utilities such as

determining polymorphisms, isolating promoters, etc. as listed on page 4 of the arguments, filed 9/21/01. It is firstly noted that applicants' arguments lacks factual basis for the determination of even a single polymorphism, promoter, etc. Therefore, this argument is an allegation without factual support. Secondly, further research would be required to even start the investigation whether any polymorphisms are determinable by the claimed nucleic acids. It is noted that applicants have not indicated that such investigation has started. It is also noted that a Patent has been stated as a reward for a successful search for an new invention and not a hunting license for one. Applicants then set forth the analogy of a microscope as having utility. This analogy does not fit the instant fact pattern. The microscope, in contrast to the instant invention, has already been established as having numerous well known utilities. One of these is the examination of biopsy tissue for cancer diagnosis. Cancer diagnosis is certainly a well established utility. Other such utilities for diagnosis are well known such as blood typing usage, for example. The list goes on extensively for utilities of a microscope. These practical and well established utilities have neither been developed nor well known for the instant inventions. None of the instantly claimed nucleic acids have been established regarding plant disease diagnosis, for example, nor whether or not they are specifically or substantially linked

in any way to plant growth, plant usage, etc. Further research is required to firstly even suggest such linkages, followed by more research by which to verify such linkages. Again applicants are seeking a Patent for a hunting license for the utility for the claimed invention and are not setting forth any successfully found utility. Applicants then argue that this utility rejection is based on a lack of exclusive utility. In response, this rejection is based on a lack of specific and substantial utility and has not been set forth regarding any exclusivity. It is not understood how a specific and substantial utility requirement has any exclusivity component. Applicants further extend this argument by misstating the basis for this rejection again regarding the golf ball analogy. This rejection statement regarding the generic utilities of nucleic acids has been set forth to illustrate the non-specificity of applicants asserted utility and not its exclusivity. Thus, applicants arguments are moot as not been directed to this specificity basis for the rejection. Applicants then summarize credibility as a requirement for a patentable utility. Since this issue also is not a basis for the rejection this argument is also moot. Applicants then argue that an asserted utility must be accepted unless information undermines the credibility of the assertion. This argument is non-persuasive because the utility requirement includes more than credibility. It includes a requirement for

specific and substantial utility. These requirements have not been satisfied by the instant disclosure and are the basis for this rejection. Thus, applicants focus on only a portion of the utility requirements is again not directed to the basis for the rejection and therefore moot. It is lastly noted that applicants have not discussed the further research which is required for determining any of the alleged utilities. If the argued credibility requirement was the "only" requirement for patentable utility then all research projects would immediately have patentable utility. It is noted that research is called research for good reason. It is that repeated searching for a useful result is not assured. That is, the useful conclusion of a research project is "only" available "after" a useful result is obtained. Up until such a time that a specific and substantial utility has been obtained, the research project could, and frequently does, end in useless failure, which is one of the reasons that it is called "research". Clearly then such a need for research, as present in the instant application, falls short of setting forth a specific and substantial utility.

ENABLEMENT REJECTION:

Claim 1 is also rejected under 35 U.S.C. § 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility for the reasons set forth above,

one skilled in the art would not know how to use the claimed invention.

This rejection is reiterated and maintained from the previous office action, mailed 6/5/01. Applicants have not argued this rejection beyond what has already been responded to above and is therefore reiterated here as equally non-persuasive regarding this rejection.

WRITTEN DESCRIPTION REJECTION:

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

This rejection is reiterated and maintained from the previous office action, mailed 6/5/01. Applicants argue that closely related nucleic acids, such as hybridizable nucleic acids, are readily recognizable. In response, applicants arguments are reasonably interpretable as being directed to nucleic acids which are apparent or obvious to someone of ordinary skill in the art meet the written basis requirement. In response such apparent or obvious inventions have been indicated as lacking written description as noted in the well known legal decisions of *In re Winkhaus et al.* (188 USPQ 129, especially at 131, first column) and *In re Symthe and Shamos* (178 USPQ 279).

The disclosure is objected to because of the following informalities:

The disclosure is objected to because it contains embedded hyperlinks and/or other forms of browser-executable code. See, for example, page 5, lines 18 and 20. Applicants are required to delete the embedded hyperlinks and/or other forms of browser-executable code. See MPEP § 608.01. It is noted that applicants have partially deleted hyperlinks in the specification. This partial deletion, however, has been ineffective regarding removal of browser-executable code. The Examiner has tested the remaining codes as amended and it is noted that a standard Netscape browser easily interpreted and executed them. Further amending to inactivate said hyperlinks so that they truly are no longer executable is yet required.

Appropriate correction is required.

No claim is allowed.

THIS ACTION IS MADE FINAL. Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

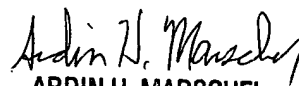
Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703)308-4242 or (703)305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (703)308-3894. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703)308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to Patent Analyst, Tina Plunkett, whose telephone number is (703)305-3524 or to the Technical Center receptionist whose telephone number is (703) 308-0196.

November 30, 2001


ARDIN H. MARSCHEL
PRIMARY EXAMINER